IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Patent Application of
DANIEL B. LODGE

Serial No. 09/938,997

Filed: August 27, 2001

For: Glass Vials with Data Matrix Codes and Method of Making the Same

Group Art Unit 1725

Examiner Geoffrey S. Evans

Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REQUEST FOR RECONSIDERATION

The Office Action of February 3, 2004 and the references cited have been carefully studied and, in view of the following representations, reconsideration and allowance of this application are most respectfully requested.

The Examiner has rejected Claim 2 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,409,742 to Arfsten et al. in view of U.S. Patent No. 6,270,738 to Wijnschenk et al., and further in view of European Patent Application No. 404,732 to Zaglio and U.S. Patent No. 6,681,055 to Sato. According to the Examiner, Arfsten et al. teach laser marking glass articles after applying a layer of ceramic paint. The Examiner states that Arfsten et al. do not disclose that laser etching a data matrix or marking the bottom end of a test tube so that it is machine readable. The Examiner believes that Wijnschenk et al. teach marking

the bottom of a test tube so that it is machine readable and that Zaglio teaches that test tubes can be made of glass. Also, the Examiner states that Sato teaches laser marking a data matrix code. The Examiner concludes that it would have been obvious to adapt Arfsten et al. in view of Wijnschenk et al., Zaglio, and Sato to laser mark the bottom of glass vials with a data matrix code so that only a small area of the vial is required for a machine-readable code. Applicant respectfully disagrees.

Arfsten et al. disclose a method for melting and/or burning–in layers of ceramic paints onto substrates of decorative glass, glass ceramic, or similar materials. Wijnschenk et al. disclose a test tube with an optically readable coding wherein the code is formed on the test tube by laser burning. Zaglio discloses an optical device for measuring the fat contents of milk. Sato discloses a method for forming a two-dimensional code by means of laser burning.

Applicant's invention is directed toward a process of forming a labeled glass vial comprising the steps of providing a generally tubular glass container having a closed bottom end and an open top end; applying ceramic paint to the bottom end of the tubular container; firing at least the bottom end of the tubular container so as to bond the paint to the bottom end; and laser etching a data matrix code into the fired bottom end wherein the data matrix code may be read by an optical reading machine.

Arfsten discloses a laser decorating method for glass using ceramic paint. It is unclear why one would laser etch a data matrix code as taught by Sato on a decorative piece of glass as disclosed in Arfsten. Neither of these references relied upon by the Examiner teaches nor suggests laser etching a data matrix code on a decorative piece of glass. While Wijnschenk et al. disclose laser etching a dot matrix code on a plastic test tube, it unclear why such a code would

be placed on a decorative piece of glass. Zaglio adds little, if anything, to the teachings of Arfsten and Wijnschenk et al. Zaglio discloses a glass test tube but the test tube is not painted nor is there any type of code etched, or in any other way, placed on the test tube. Therefore, Applicant does not believe that the references relied upon by the Examiner have been properly combined or that they teach or suggest Applicant's process.

The Examiner has rejected Claim 2 under 35 U.S.C. §103(a) as being unpatentable over U.S. Published Patent Application No. 2002/0102362 to Schneider in view of U.S. Patent No. 6,681,055 to Sato and further in view of U.S Patent No. 6,372,293 to Mathus et al. According to the Examiner Schneider discloses making laboratory containers such as a glass vial by applying ceramic based paint and etching the label area with a laser. The Examiner states that Schneider discloses using a bar code rather than a data matrix code but that Sato teaches laser marking a data matrix code instead of a bar code because it has a higher data amount per unit area. The Examiner also states that Mathus et al. teach placing a code on the bottom of a test tube and that it would have been obvious to adapt Schneider in view of Sato to increase the amount of data in the code per unit area and further to adapt Schenider in view of Mathus et al. to place it at the bottom end so that it is easily machine readable. Applicant respectfully disagrees.

Applicant objects to the use of Schneider as prior art. That is, the Examiner relies on Schneider for the teaching of making laboratory containers by applying a ceramic based paint and etching the label area with a laser. The effective filing date for this specific disclosure is January 31, 2002. Schneider does not receive the benefit of the filing date of the provisional application filed on February 1, 2001 for this specific disclosure because the provisional application does not disclose the use of ceramic based paint. (See the attached copy of the

provisional application obtained from the Patent and Trademark Office.) Rather, the use of ceramic based paint was only added in the published application. Applicant's present application has an effective filing date of August 27, 2001. Applicant's application, therefore, pre-dates the Schneider application and cannot be used as prior art. Application respectfully requests that this rejection be withdrawn.

Furthermore, neither Sato nor Mathus et al. teaches or suggests Applicant's invention. As discussed above, Sato discloses a method for forming a two-dimensional code by means of laser burning. Mathus et al. disclose a test tube with machine readable data matrix code markings thereon that uniquely identify the test tube. Neither of these references, taken alone or in combination, discloses or suggests Applicants claimed method for forming a ceramic painted, labeled glass vial.

In view of all the foregoing, Applicant submits that all of the claims presently in the application clearly and patentably distinguish over the references of record and should be allowed. It is believed that this application is in condition for allowance and an early action toward that end is most respectfully solicited.

Respectfully submitted,

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Dated: April 30, 2004